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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/178,840	10/26/98	TRIANTAFYLLOU	F-[illegible]-L2

002352
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IM22/1020

EXAMINER	
SHERRER, C	
ART UNIT	**PAPER NUMBER**
1761	5

DATE MAILED: 10/20/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/178,840	Applicant(s) Triantafyllou
	Examiner Curtis E. Sherrer	Group Art Unit 1761

☒ Responsive to communication(s) filed on *Aug 26, 1999*.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-21* is/are pending in the application.

Of the above, claim(s) *10-21* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-9* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *2*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Election/Restriction

1. Claims 10-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected products, the requirement having been traversed in Paper No. 5.

2. Applicant's election with traverse of the restriction in Paper No. 5 is acknowledged. The traversal is on the ground(s) that "the alleged separate products are merely speculative assertions and cannot support a restriction requirement." This is not found persuasive because Applicant has not shown why the restricted product cannot be made by the method suggested.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 5 and 6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the

art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5. The claims recite using a heat treated malted cereal whereby said malt is treated "to destroy essentially all B-glucanase activity" or to "sufficiently [] inactivate essentially all B-glucanase contained therein." The specification provides no description as to how this process is performed but only discloses one product (Havrenjol C45), presumably obtainable in Sweden, that meets the above limitations. If this single source of the heat treated malted cereal was to be discontinued, those in the art would be unable to practice the claimed invention. See *In re Howarth,* 654 F.2d 103, 210 USPQ 689 (CCPA 1981).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The scope of the phrases "high content of soluble B-glucan" (Claims 1 and 2) and "essentially lacks B-glucanase activity" (and variations thereof) (Claims 2, 5 and 6) is unknown.

9. It is unclear on what basis the range "from 10 to 30% by weight" is based. From the specification it appears that it is based on "by volume." Further, it is unclear what weight, i.e., pounds, kilograms, etc., and what volume, i.e., gallons, pints, liters, etc., the range is based on.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 4 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Breworld (www.breworld.com/homebrew/recipes/ps6.html).

12. Breworld teaches the production of "DB's Oatmeal Stout," whereby the recipe calls for one kilogram of oatmeal, 4 ounces of roast barley (and other grains) to be mixed with 1.5 gallons (about 6 liters) of water. This would be about 15% by weight of at least one grain which essentially lack B-glucanase activity. The grain/water mash is heated up to 70 C, sparged (removal of insolubles), boiled with hops (which inherently destroys all enzymatic activity), yeast is added and it is fermented. Inherently, the final product will have "a high content of soluble B-glucan." Also, because the process as claimed is performed by the cited prior art, the final product will inherently have "more than 50% of soluble B-glucan contained in the cereal is preserved in the final product."

13. The Office does not have the facilities for examining and comparing Applicant's product with the product of the prior art in order to establish that the product of the prior art does not

possess the same material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed are functionally different than those taught by the prior art and to establish patentable differences. See *In re Best*, 562 F.2d 1252, 195 U.S.P.Q. 430 (CCPA 1977); *Ex parte Gray*, 10 U.S.P.Q.2d 1922, 1923 (BPAI).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Breworld.

16. Breworld teaches that cited above, but does not teach the addition of boiled malt wort to the cereal wort. It is notoriously well known to use malt extract (a condensed boiled malt wort) in the production of beer and therefore it would have been obvious to those of ordinary skill in the art to add said extract in the production of the oatmeal Stout cited above.

17. Finally, Applicants' attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

Conclusion

18. No claim is allowed.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Foehse (USPN 5,063,078) discloses a method of prodcing a high soluble fiber barley fraction.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lacey, can be reached on (703)-308-3535. The **fax phone number** for this Group is (703)-305-3602.

23. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Curtis E. Sherrer

October 19, 1999